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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,539	06/25/2003	Stephen Penrice	20339.16	4064
49358	7590	11/29/2005	EXAMINER	
CARLTON FIELDS, PA 1201 WEST PEACHTREE STREET 3000 ONE ATLANTIC CENTER ATLANTA, GA 30309			COBURN, CORBETT B	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/603,539

Applicant(s)

PENRICE, STEPHEN

Examiner

Corbett B. Coburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-34, 37-42 and 58-61 is/are pending in the application.
- 4a) Of the above claim(s) 25-34 and 37-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 58-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claim 25 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The previous claims (Invention I) and the current claims (Invention II) are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as a game without wildcards. See MPEP § 806.05(d).

2. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25-34 & 37-42 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Applicant should note that the amendment of claim 25 completely changes the games claimed. In the unamended claims, the game was concerned with replacing matching indicia (i.e., wildcards). The amended claims have nothing about replacing matching indicia. Instead, the amended claims are concerned with the random multiplier. These are completely different games requiring completely different searches.

Claim Rejections - 35 USC § 112

4. Claims 59-61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Art Unit: 3714

The limitation, “the random multiplier being independent of an outcome of said game” is not supported in the specification and is new matter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 58-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banyai in view of Heidel et al. (US Patent Number 5,342,047).

Claims 58-61: Banyai teaches the invention substantially as claimed (including a lottery controller with processor and memory coupled to the lottery terminals) – see previous office action, which is hereby incorporated by reference. Banyai does not teach printing tickets. Heidel teaches a video lottery system that includes a ticket printer (48). Printing tickets for video lottery systems is extremely well known to the art. Such tickets provide a record of play (as required by gaming regulations) as well as allowing video lottery terminals to be placed in non-secure areas by separating the cash paid as a prize from the machine itself. In order to provide a record of play, the tickets would necessarily include the indicia of the first type with one or more of the indicia of the first type replaced with indicia of the second type – i.e., it would list the indicia played/winning combination. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Banyai in view of Heidel to include a ticket printer in order to provide a record of play (as required by gaming regulations) and allow the video

Art Unit: 3714

lottery terminals to be placed in non-secure areas by separating the cash paid as a prize from the machine itself.

Claim 59: Banyai teaches that the controller is programmed to randomly associate the multiplier factor with said indicia of a second type. If the winning combination is dependent on the presence of a wild indicium (indicia of the second type), then the prize value is adjusted. (Col 6, 33-36) The multiplier itself is not dependent on the outcome of the game -- the award of the prize depends on the outcome, not the multiplier.

Response to Arguments

7. Applicant's arguments filed 14 July 2005 have been fully considered but they are not persuasive.

8. With regard to claim 58, Applicant argues that Banyai fails to teach a lottery controller that is programmed to replace first indicia with second indicia. This limitation is no longer in the claim.

9. With respect to claims 59-61, the arguments are drawn to the claims as amended and are addressed in the rejection above.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

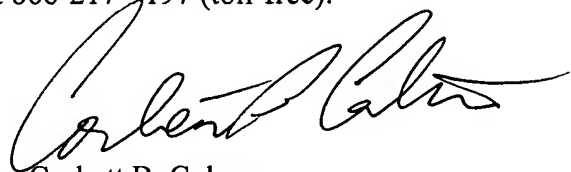
Art Unit: 3714

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl J. Tyler can be reached on (571) 272-4834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Corbett B. Coburn', is written over the printed name and title.

Corbett B. Coburn
Examiner
Art Unit 3714